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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/590,075

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Eiji Ueda

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EXAMINER

PATEL, HARESH N

ART UNIT

PAPER NUMBER

2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/590,075

Applicant(s)

UEDA ET AL.

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 32 and 34-43 are subject to examination. Claims 1-31 and 33 are cancelled.

Response to Arguments

2. Applicant's arguments filed 10/23/06, pages 6-17, have been fully considered but they are not persuasive. Therefore, rejection of claims 32, 34-43 is maintained.

Applicant states, (1) "Request for examiner-initialed copy of September 19, 2005 Form PTO-1449".

For clarification, this IDS has been acknowledged and an examiner-initialed copy of September 19, 2005 Form PTO-1449 was provided on 1/31/2006; and which is already part of the application (prosecution history). Since, the applicant has access to the e-DAN (pair system), the applicant is requested to print the 1/31/2006 signed document. It is recommended that sending another copy to the applicant would duplicate the same document in the system and would complicate the handling of the documents in the system.

Applicant states (2), "Without intending to acquiesce to this rejection, independent claims 32 and 37 have each been amended in order to more clearly illustrate the marked differences between the present invention and the applied references. Accordingly, the Applicants respectfully submit that the present invention is clearly patentable over the applied references for the following reasons".

The examiner respectfully disagrees in response to the applicant's arguments. The amendment to the claims in fact removed the limitations of using broadcast channel from the

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claims (see claim 32) and made the claims broader than the previously presented claims. The examiner agrees with the applicant that amendment to the claims is in order to more clearly illustrate the marked differences between the present invention and the applied references, meaning that no new limitations are added compared to the previously presented claims.

Regarding the applicant to provide amended limitations with the usage of "wherein" in the claims, please refer to the MPEP rules and regulations because the usage of "wherein" and/or "whereby" in the claimed subject matter of the claims, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. See *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003). MPEP 2111.

Applicant states (3), "the cited reference(s) does not disclose or suggest receiving a plurality of multimedia data and attribute information that are included independently of each other in the broadcast data".

The examiner respectfully disagrees in response to the applicant's arguments. The cited reference, Vallone discloses receiving broadcast data (e.g., col., 6, lines 29 – 44), where the broadcast data includes both a plurality of multimedia data (e.g., video data, col., 5, lines 4 – 50) and attribute information (e.g., broadcast control information and/or compression information related to the multimedia data, col., 7, lines 24 - 38) which respectively corresponds to the plurality of received multimedia data (e.g., col., 6, lines 29 – 44) that are included independently of each other in the broadcast data (e.g., col., 6, lines 29 – 44).

Regarding the applicant's comment, "On page 3 of the Office Action, the Examiner asserts that because claims 32 and 37 are open ended (comprising) and lines 19-23 on page 53 of the specification provide that "numerous other modifications and variations can be devised without departing from the scope of the invention," the Examiner purports that his interpretation of the applied references teach all the limitations of claims 32 and 37", This assertion is contrary to the well-settled provisions of U.S. patent law. An Examiner is afforded a broad reasonable interpretation of the features that are recited in a claimed invention. However, just because a claim is open ended (comprising) does not permit an Examiner to forego his burden of establishing a prima facie case of obviousness"; the examiner would like to clarify that the the office action dated 4/21/2006 indeed contain proper rejections and all the claimed limitations are in fact considered and the all the limitations are rejected using the cited arts. In fact, the limitations are so broad that more than several arts used for the rejections are disclosing the limitations as cited in the office action dated 4/21/2006. The applicant to not agree with the rejections and cited art teachings and to maintain that the broadly claimed subject matter is novel even though it is disclosed by several references of the office action dated 4/21/2006, does not mean that the prima facie case of obviousness is not meet. The examiner is unable to understand what the applicant's "open ended (comprising)" concern has to do with "burden of establishing a prima facie case of obviousness".

The applicant failed to provide where in the MPEP (the well-settled provisions of U.S. patent law, exists), which does not allow considering the lines 19-23 of page 53 of the specification of this application under prosecution providing "numerous other modifications and variations can be devised without departing from the scope of the invention". In fact, it is the

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applicant who provided the specification and the claims and the claims are interpreted based upon what is claimed, and to which the MPEP rules and regulations are applicable.

In fact, MPEP rules and regulations consider the claimed subject matter patentable that is presented in the claims and not what all is in the specification. Please refer to *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), “Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims”. The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970).

The claimed invention of claim 32 contains units that are merely “operable” (see claim 32). The claimed invention of claim 37 accomplishes sequentially receiving the plurality of multimedia data and the attribute information, outputting the received multimedia data, storing the plurality of received multimedia data and the attribute information, creating management information for collectively managing the plurality of received multimedia data and the attribute information, managing the plurality of multimedia data and the attribute information included in the broadcast data, and managing the received multimedia data with reference to the attribute information associated with the management information.

Regarding the applicant’s concern, that an Examiner is afforded a broad reasonable interpretation of the features that are recited in a claimed invention, and the applicant selected multimedia data and attribute information from the cited references (i.e., conveniently misinterpreted and/or misleading the teachings and the disclosure of the cited references) are not relevant to the claimed invention because the claimed invention only contains that the multimedia data and attribute information is received and there is no requirement from where the

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multimedia and attribute information is coming from (i.e., from within or from outside, etc, the broadcasted data, as there is no broadcasting step, it is just that the data type is being broadcast data). The claimed invention contain receiving device (not transmitting device) regarding the output the received multimedia data and there is no requirement where the multimedia data is outputted to (i.e., to outside or within, etc). Regarding the applicant's concern about the multimedia data and the attributed information are included independently of each other in the broadcast data, the claimed invention contain only sequentially receiving the plurality of multimedia data and the attribute information. In fact, regarding limitations, "receiving the plurality of multimedia data and the attribute information", the plurality of multimedia data and the attribute information of the broadcast data cannot exist by itself, as claimed. Regarding limitations, "independently of each other in the broadcast data", both multimedia data and the attribute information are part of the broadcast data and the attribute information includes start-up information of the multimedia data, hence in fact they both are dependent on each other (see claim 36). Claim 34 also states, "the attribute information includes information indicating a data type of the multimedia data" (hence dependent). In fact, the claimed invention is so broad that it does not contain what is meant by independent (the claimed subject matter fails to define what is considered as independent). The applicant is requested to consider what is claimed, i.e., usage of "wherein", "for", etc. Regarding, storing the plurality of received multimedia data and the attribute information, besides teachings of the cited art, one skilled in the art at the time of the invention very well knows that the data and the information cannot exist by itself after receiving and must require storing. Regarding, creating management information for collectively managing the plurality of received multimedia data and the attribute information, besides teachings of the

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cited references, one skilled in the art at the time of the invention very well knows that after receiving, information has to be created for use. The received information, i.e., the data and the attribute information, must require information managing them. Regarding the managing of the received multimedia data with reference to the attribute information associated with the management information, besides teachings of the cited references, one skilled in the art at the time of the invention very well knows that since the multimedia data and the attribute information of the cited references are associated with each other, managing of the received multimedia data with reference to the attribute information associated with the management information is necessary. The applicant is also requested to consider that besides the cited arts used for the rejection of the broadly claimed subject matter, several arts that are cited under the claims 38-41 are also pertinent to the claimed subject matter as they all disclose the broadly claimed subject matter of the claims. Contrary to the applicant's assertions, the fact is that none of the limitations are novel considering the disclosure of multiple cited art references; please see office action dated 10/23/2006. Further, the claim is open-ended (comprising), and page 53, lines 19-23 of the specification, clearly states, "While the invention has been described in detail, the foregoing description is in all aspects illustrative and not restrictive. It is understood that numerous other modifications and variations can be devised without departing from the scope of the invention". Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant states (4), "it is impossible for one skilled in the art to combine the teachings of the references for the claimed limitations of the claims".

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The examiner respectfully disagrees in response to applicant's arguments. First, a reference citing alternatives does not mean that the other alternative is teaching away or defeat the purpose of the other reference. Unrelated alternatives have their own advantages and disadvantages and which has nothing to do with what is claimed in the claims. There is no need to combine systems of the references in order to utilize the concept disclosed in the another art.

The applicant's assertion is misleading and/or irrelevant because the claimed invention accomplishes a broadcast data receiving device for receiving and outputting broadcast data (please see claims 32, 37), which all the arts used for the combination of the teachings of the claimed subject matter are concerned to and related. The fact is that several references of the office action dated 4/21/2006 disclose all the claimed limitations of the claims. To further clarify limitations that are not specifically mentioned, which are inherent and/or obvious, other references are provided to realize that the combination of the references disclose the limitations with overlapping disclosures and teachings.

Also, it is well established that a conclusion of obviousness may be made based on a combination of references based on a reason, suggestion or motivation to lead an inventor to combine those references. *In re Pro-Mold and Tool Co. v. Great Lakes Plastic Inc.*, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). There is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993).

Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 32, 34, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone et al. 6,642,939 (Hereinafter Vallone-TiVoInc) in view of Vynne et al., 5,960,081, Cray Research, (Hereinafter Vynne-Cray) and MPEG-7: Applications and Supporting Technologies, pages 61-64, Mohamed Abdel-Mottaleb et al., 1998, See IDS, (Hereinafter Mohamed), as per office action, paper dated 4/21/2006.

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5. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc, Vynne-Cray and Mohamed in view of "Official Notice", as per office action, paper dated 4/21/2006. For example, Fujii, Sony Corportation, 6,204,842, paragraph 12; Augenbraum et al., 20050149981, Sedna, paragraph 23; Atkinson, 20010039571, paragraph 53; Gruse et al., 6,398,245, IBM, paragraph 320, Inala et al., 6,442,590, Yodlee.com, paragraph 59; Jain et al., 6,360,234, Virage, paragraph 88; and/or Nielsen, Sun Microsystems, 6,510,461, paragraphs 8, 10 and 40, discloses the limitations rejected under "Official Notice".

6. Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc, Vynne-Cray and Mohamed in view of Shoff et al., 6,240,555, Microsoft (Hereinafter Shoff-Microsoft) and "Official Notice", as per office action, paper dated 4/21/2006. For example, Fujii, Sony Corportation, 6,204,842, paragraph 12; Augenbraum et al., 20050149981, Sedna, paragraph 23; Atkinson, 20010039571, paragraph 53; Gruse et al., 6,398,245, IBM, paragraph 320, Inala et al., 6,442,590, Yodlee.com, paragraph 59; Jain et al., 6,360,234, Virage, paragraph 88; and/or Nielsen, Sun Microsystems, 6,510,461, paragraphs 8, 10 and 40, discloses the limitations rejected under "Official Notice".

7. Claim 32, 34, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc in view of Vynne-Cray and Augenbraun et al., 5,857,181, Hitachi (Hereinafter Augenbraun-Hitachi)", as per office action, paper dated 4/21/2006.

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8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc, Vynne-Cray and Augenbraun-Hitachi in view of "Official Notice", as per office action, paper dated 4/21/2006. For example, Fujii, Sony Corportation, 6,204,842, paragraph 12; Augenbraum et al., 20050149981, Sedna, paragraph 23; Atkinson, 20010039571, paragraph 53; Gruse et al., 6,398,245, IBM, paragraph 320, Inala et al., 6,442,590, Yodlee.com, paragraph 59; Jain et al., 6,360,234, Virage, paragraph 88; and/or Nielsen, Sun Microsystems, 6,510,461, paragraphs 8, 10 and 40, discloses these limitations, discloses the limitations rejected under "Official Notice".

9. Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc, Vynne-Cray and Augenbraun-Hitachi in view of Shoff et al., 6,240,555, Microsoft (Hereinafter Shoff-Microsoft) and "Official Notice", as per office action, paper dated 4/21/2006. For example, Fujii, Sony Corportation, 6,204,842, paragraph 12; Augenbraum et al., 20050149981, Sedna, paragraph 23; Atkinson, 20010039571, paragraph 53; Gruse et al., 6,398,245, IBM, paragraph 320, Inala et al., 6,442,590, Yodlee.com, paragraph 59; Jain et al., 6,360,234, Virage, paragraph 88; and/or Nielsen, Sun Microsystems, 6,510,461, paragraphs 8, 10 and 40, discloses the limitations rejected under "Official Notice".

10. Claim 32, 34, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc in view of Vynne-Cray and WO 99/22502, May 6, 1999, Wright et al., Microsoft, PCT/US98/19350 (Hereinafter Wright-Microsoft), as per office action, paper dated 4/21/2006.

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11. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc, Vynne-Cray and Wright-Microsoft in view of "Official Notice", as per office action, paper dated 4/21/2006. For example, Fujii, Sony Corportation, 6,204,842, paragraph 12; Augenbraum et al., 20050149981, Sedna, paragraph 23; Atkinson, 20010039571, paragraph 53; Gruse et al., 6,398,245, IBM, paragraph 320, Inala et al., 6,442,590, Yodlee.com, paragraph 59; Jain et al., 6,360,234, Virage, paragraph 88; and/or Nielsen, Sun Microsystems, 6,510,461, paragraphs 8, 10 and 40, discloses the limitations rejected under "Official Notice".

12. Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone-TiVoInc, Vynne-Cray and Wright-Microsoft in view of Shoff et al., 6,240,555, Microsoft (Hereinafter Shoff-Microsoft) and "Official Notice", as per office action, paper dated 4/21/2006. For example, Fujii, Sony Corportation, 6,204,842, paragraph 12; Augenbraum et al., 20050149981, Sedna, paragraph 23; Atkinson, 20010039571, paragraph 53; Gruse et al., 6,398,245, IBM, paragraph 320, Inala et al., 6,442,590, Yodlee.com, paragraph 59; Jain et al., 6,360,234, Virage, paragraph 88; and/or Nielsen, Sun Microsystems, 6,510,461, paragraphs 8, 10 and 40, discloses the limitations rejected under "Official Notice".

Conclusion

13. The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is considered pertinent to applicant's disclosure. For example, Debey, 6,519,693, Delta Beta, also discloses the concept of attribute information being a table (structure) of information as presented in the claims (e.g., figures 1 and 2).

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The

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examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
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Haresh Patel

December 26, 2006